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EXAMINER
PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
2645	6

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/518,790	BOSSEMEYER ET AL.	
	Examiner	Art Unit	
	Joseph T Phan	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17,37,38 and 41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-17,37,38 and 41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *18-36,39,40 and 42-48* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-17, 37-38, and 41 drawn to performing text-to-speech synthesis of Caller ID information externally in the telephony network then forward speech announcement to a substation(subscriber's telephone unit) during call waiting classified in class 379, subclass 142.08.

   II. Claims 18-36, 39-40, and 42-48, drawn to performing text-to-speech synthesis of Caller ID information and generating verbal announcement locally by the subscriber's telephone unit, classified in class 379, subclass 88.21.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the text-to-speech data synthesis is performed at the network side and does not require the subscriber's telephony unit to perform processing. The subcombination has separate utility such that the subscriber's

telephone unit can perform text-to-speech synthesis locally, without the prior need of conversion and generation of data externally at the network side.

See applicant's specification of the disclosed separate inventions on page 24 lines 19-29.

Because, inventions I and II are unrelated for the reason given above and have acquired a separate status in the art as show by their different classifications, and because of their recognized divergent subject matter, and the search required for group I is not required for group II, and vice versa, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Joseph F. Hetz on August 13th, 2003 a provisional election was made without traverse to prosecute the invention of Bossemeyer et al., Group I text-to-speech synthesis at the network side. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-36, 39-40, and 42-48 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17, 37-38, and 41 rejected under 35 U.S.C. 102(e) as being anticipated by Bull et al., Patent #6,498,841.

Regarding claim 1, Bull teaches a method for performing distributed text-to-speech synthesis by a telephone network coupled to a first telephone subscriber unit and a second telephone subscriber unit(Fig.2), the first telephone subscriber unit having a first telephone number and associated with a first party by the telephone network(220 Fig.2), and the second telephone subscriber unit having a second telephone number and associated with a second party by the telephone network (222 or 224 Fig.2), the method comprising the steps of:

receiving a telephone call from the first telephone subscriber unit to the telephone network over a first communication channel responsive to the first telephone subscriber unit originating the telephone call to the second telephone subscriber unit through the telephone network(Fig. 5, col.3 lines 38-61 and col.6 lines 11-16);

determining that the second party subscribes to a speech-based caller identification service provided by the telephone network responsive to the step of receiving the telephone call (302 Fig.3 and col.6 lines 12-51);

retrieving text information, representing caller identification information of the first party, from a database stored in a network memory device responsive to the step of determining (306-310 Fig.4);

converting the text information into symbols, representing the caller identification information of the first party, responsive to the step of retrieving and encoding the symbols to form a data stream representing the caller identification information of the first party(306-308 Fig.3);

opening a second communication channel between the telephone network and the second telephone subscriber unit responsive to the step of encoding (500 Fig.5); and sending the data stream from the telephone network to the second telephone subscriber unit over the second communication channel responsive to the step of opening (504 Fig.5 and col.9 line 43-col.10 line 33-45).

Regarding claim 2, Bull teaches a method according to claim 1 further comprising the steps of: receiving a request from the second telephone subscriber unit over the second communication channel that the telephone network route the telephone call to the second telephone subscriber unit responsive to the step of sending the data stream(506-512 Fig.5); and

routing the telephone call through the telephone network from the first telephone

subscriber over the first communication channel unit to the second telephone subscriber unit over the second communication channel responsive to the step of receiving the request (512-END Fig.5).

Regarding claim 3, Bull teaches a method according to claim 1 further comprising the steps of placing the first telephone subscriber unit on hold responsive to the step of determining;

sending a ringing signal to the first telephone subscriber unit over the first communication channel responsive to the step of placing, wherein the step of retrieving the text information is performed responsive to the step of sending the ringing signal(506 Fig.5);

receiving a request from the second telephone subscriber unit over the second communication channel that the telephone network route the telephone call to the second telephone subscriber unit (506-512 Fig.5);

stopping the sending of the ringing signal to the first telephone subscriber unit over the first communication channel responsive to the step of receiving the request(END Fig.5);

taking the first telephone subscriber unit off hold responsive to the step of stopping and routing the telephone call through the telephone network from the first telephone subscriber unit over the first communication channel to the second telephone subscriber unit over the second communication channel responsive to the step of taking the first telephone subscriber unit off hold (512-END Fig.5).

Regarding claim 4, Bull teaches a method according to claim 1 further comprising the step of determining that the transmission of the data stream from the telephone

network to the second telephone subscriber unit over the second communication channel is successful responsive the step of sending the data stream and responsive to a response from the second telephone subscriber unit over the second communication channel that the transmission of the data stream from the telephone network to the second telephone subscriber unit is successful, wherein the step of receiving the request is responsive to the step of determining that the transmission of the data stream from the telephone network to the second telephone subscriber unit over the second communication channel is successful(504-512 Fig.5).

Regarding claim 5, Bull teaches a method according to claim 1 further comprising the step of sending a ringing signal to the second telephone subscriber unit over the second communication channel responsive the step of sending the data stream, wherein the step of receiving the request is responsive to the step of sending the ringing signal (506 Fig.5).

Regarding claim 9, Bull teaches a method for performing distributed text-to-speech synthesis by a telephone network coupled to a first telephone subscriber unit and a second telephone subscriber unit (Fig.2), the first telephone subscriber unit having a first telephone number and associated with a first party by the telephone network(220 Fig.2), and the second telephone subscriber unit having a second telephone number and associated with a second party by the telephone network (222 or 224 Fig.2), the method comprising the steps of:

receiving a telephone call from the first telephone subscriber unit to the

telephone network over a first communication channel responsive to the first telephone subscriber unit originating the telephone call to the second telephone subscriber unit through the telephone network(Fig. 5, col.3 lines 38-61 and col.6 lines 11-16);

determining that the second party subscribes to a speech-based caller identification service provided by the telephone network responsive to the step of receiving the telephone call (302 Fig.3 and col.6 lines 12-51);

placing the first telephone subscriber unit on hold responsive to the step of determining and sending a ringing signal to the first telephone subscriber unit over the first communication channel responsive to the step of placing (Fig.3 and 402 Fig.4);

retrieving text information, representing caller identification information of the first party, from a database stored in a network memory device responsive to the step of determining (306-310 Fig.4);

converting the text information into symbols, representing the caller identification information of the first party, responsive to the step of retrieving and encoding the symbols to form a data stream representing the caller identification information of the first party(306-308 Fig.3);

opening a second communication channel between the telephone network and the second telephone subscriber unit responsive to the step of encoding (500 Fig.5); and sending the data stream from the telephone network to the second telephone subscriber unit over the second communication channel responsive to the step of opening (504 Fig.5).

sending a ringing signal to the second telephone subscriber unit over the second

communication channel responsive to the step of sending the data stream (506 Fig.5);

receiving a request from the second telephone subscriber unit over the second communication channel that the telephone network route the telephone call to the second telephone subscriber unit responsive to the step of sending the ringing signal to the second telephone subscriber unit over the second communication channel (506-512 Fig.5); stopping the sending of the ringing signal to the first telephone subscriber unit over the second communication channel responsive to the step of receiving the request (END Fig.5); taking the first telephone subscriber unit off hold responsive to the step of stopping; and routing the telephone call through the telephone network from the first telephone subscriber unit over the first communication channel to the second telephone subscriber unit over the second communication channel responsive to the step of taking the first telephone subscriber unit off hold (512-END Fig.5 and col.9 line 43-col.10 line 33-45).

Regarding claim 10, Bull teaches a method according to claim 9 further comprising the steps of:

determining that the transmission of the data stream from the telephone network to the second telephone subscriber unit over the second communication channel is successful responsive the step of sending the data stream and responsive to a response from the second telephone subscriber unit that the transmission of the data stream from the telephone network to the second telephone subscriber unit over the second communication channel is successful(504-512 Fig.5),

wherein the step of sending the ringing signal is responsive to the step of determining that the transmission of the data stream from the telephone network to the second telephone subscriber unit over the second communication channel is successful (504-512 Fig.5).

Regarding claim 14, Bull teaches a method for performing distributed text-to-speech synthesis by a telephone network coupled to a first telephone subscriber unit and a second telephone subscriber unit (Fig.2), the first telephone subscriber unit having a first telephone number and associated with a first party by the telephone network(220 Fig.2), and the second telephone subscriber unit having a second telephone number and associated with a second party by the telephone network (222 or 224 Fig.2), the method comprising the steps of:

receiving a telephone call from the first telephone subscriber unit to the telephone network over a first communication channel responsive to the first telephone subscriber unit originating the telephone call to the second telephone subscriber unit through the telephone network(Fig. 5, col.3 lines 38-61 and col.6 lines 11-16);

determining that the second party subscribes to a speech-based caller identification service provided by the telephone network responsive to the step of receiving the telephone call (302 Fig.3 and col.6 lines 12-51);

placing the first telephone subscriber unit on hold responsive to the step of determining and sending a ringing signal to the first telephone subscriber unit over the first communication channel responsive to the step of placing (Fig.3 and 402 Fig.4);

retrieving text information, representing caller identification information of the first

party, from a database stored in a network memory device responsive to the step of determining (Fig.3 and 306-310 Fig.4);

converting the text information into symbols, representing the caller identification information of the first party, responsive to the step of retrieving and encoding the symbols to form a data stream representing the caller identification information of the first party(306-308 Fig.3);

opening a second communication channel between the telephone network and the second telephone subscriber unit responsive to the step of encoding (500 Fig.5); and sending the data stream from the telephone network to the second telephone subscriber unit over the second communication channel responsive to the step of opening (504 Fig.5).

determining that the transmission of the data stream from the telephone network to the second telephone subscriber unit over the second communication channel is successful responsive the step of sending the data stream and responsive to a response from the second telephone subscriber unit over the second communication channel that the transmission of the data stream from the telephone network to the second telephone subscriber unit over the second communication channel is successful (504-512 Fig.5);

sending a ringing signal to the second telephone subscriber unit over the second communication channel responsive to the step of determining that the transmission of the data stream over the second communication channel is successful (506 Fig.5);

receiving a request from the second telephone subscriber unit over the second

communication channel that the telephone network route the telephone call to the second telephone subscriber unit over the second communication channel responsive to the step of sending the ringing signal to the second telephone subscriber unit (512 Fig.5);

stopping the sending of the ringing signal to the first telephone subscriber unit over the first communication channel responsive to the step of receiving the request (512-END Fig.5);

taking the first telephone subscriber unit off hold responsive to the step of stopping; and routing the telephone call through the telephone network from the first telephone subscriber unit over the first communication channel to the second telephone subscriber unit over the second communication channel responsive to the step of taking the first telephone subscriber unit off hold (512-END Fig.5).

Regarding claim 37, Bull teaches a telephone network coupled to a first telephone subscriber unit and a second telephone subscriber unit, the first telephone subscriber unit having a first telephone number and associated with a first party by the telephone network, and the second telephone subscriber unit having a second telephone number and associated with a second party by the telephone network (col.3 line 62-col.4 line 11),

the telephone network comprising:

a central telephone office for performing a step of receiving a telephone call from the

first telephone subscriber unit to the telephone network over a first communication channel responsive to the first telephone subscriber unit originating the telephone call to the second telephone subscriber unit through the telephone network (218 Fig.2 and col.6 lines 11-16);

a service control point, coupled to the central telephone office, for performing a step of determining that the second party subscribes to a speech-based caller identification service, provided by the telephone network responsive to the step of receiving the telephone call (206 Fig.2);

a network services node, coupled to the central telephone office and the service control point, for performing steps of retrieving text information, representing caller identification information of the first party, from a database stored in a network memory device responsive to the step of determining (212 and 216 Fig.2);

converting the text information into symbols, representing the caller identification information of the first party, responsive to the step of retrieving; and encoding the symbols to form a data stream representing the caller identification information of the first party; wherein the central telephone office further performs steps of opening a second communication channel between the telephone network and the second telephone subscriber unit responsive to the step of encoding; and sending the data stream from the telephone network to the second telephone subscriber unit over the second communication channel responsive to the step of opening (col.4 line 59-col.5 line 15).

Regarding claim 38, Bull teaches a telephone network coupled to a first telephone subscriber unit and a second telephone subscriber unit, the first telephone subscriber unit having a first telephone number and associated with a first party by the telephone network, and the second telephone subscriber unit having a second telephone number and associated with a second party by the telephone network (Fig.2), the telephone network comprising:

means for performing a step of receiving a telephone call from the first telephone subscriber unit to the telephone network over a first communication channel responsive to the first telephone subscriber unit originating the telephone call to the second telephone subscriber unit through the telephone network (218 Fig.2, Fig. 5, col.3 lines 38-61 and col.6 lines 11-16);

means for performing a step of determining that the second party subscribes to a speech based caller identification service provided by the telephone network responsive to the step of receiving the telephone call (Fig.2);

means for performing a step of retrieving text information, representing caller identification information of the first party, from a database stored in a network memory device responsive to the step of determining (206-210 Fig.2);

means for performing a step of converting the text information into symbols, representing the caller information of the first party and for performing a step of encoding the symbols to form a data stream (216 Fig.2);

means for performing a step of opening a second communication channel between the telephone network and second subscriber unit and for performing a step of sending the

data stream from the telephone network to the second telephone subscriber unit over the second communication channel (218 Fig.2 and col.9 line 48-col.10 line 59).

Regarding claim 41, Bull teaches a telephone network coupled to a first telephone subscriber unit and a second telephone subscriber unit, the first telephone subscriber unit having a first telephone number and associated with a first party by the telephone network, and the second telephone subscriber unit having a second telephone number and associated with a second party by the telephone network(col.3 line 62-col.4 line 11), the telephone network including a central telephone office for performing a step of receiving a telephone call from the first telephone subscriber unit to the telephone network over a first communication channel responsive to the first telephone subscriber unit originating the telephone call to the second telephone subscriber unit through the telephone network(218 Fig.2), the telephone network including a service control point for performing a step of determining that the second party subscribes to a speech-based caller identification service provided by the telephone network responsive to the step of receiving the telephone call(206 Fig.2), an article in the telephone network comprising:

a computer-readable data storage medium and means recorded on the computer-readable data storage medium for performing a step of retrieving text information, representing caller identification information of the first party, from a database stored in a network memory device responsive to the step of determining (206-210 Fig.2);

means recorded on the computer-readable data storage medium for performing a step of converting the text information into symbols, representing the caller identification information of the first party, responsive to the step of retrieving; and

means recorded on the computer-readable data storage medium for performing a step of encoding the symbols to form a data stream representing the caller identification information of the first party (216 Fig.2 and col.8 lines 58-col.9 ilne 67);

wherein the central telephone office further performing steps of:

opening a second communication channel between the telephone network and the second telephone subscriber unit responsive to the step of encoding; and sending the data stream from the telephone network to the second telephone subscriber unit over the second communication channel responsive to the step of opening(col.9 line 48-col.10 line 67).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6-8, 11-13, and 15-17 rejected under 35 U.S.C. 103(a) as being unpatentable over (Mitome, Patent #5,204,905 or Acero et al., Patent #6,163,769).

Regarding claims 6-8, 11-13, and 15-17 Bull teaches a method of performing text-to-speech synthesis according to claims 1, 9, and 14.

Bull does not expressly disclose the interworkings of his text-to-speech system(216 Fig.2) to specifically detail that the text to speech conversions within it include phonemic and prosodic information.

Mitome and Acero discloses the interworking details of a text-to-speech system that include phonemic and prosodic information parameters which Bull is silent on (Mitome Fig.1 and Acero Fig.2).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a text-to-speech system as disclosed by Mitome and Acero which provides phonemic and prosodic information parameters as text-to-speech systems that uses these information were well-known and commonly used in the art of text-to-speech synthesis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 8:30-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.
JTP
August 21, 2003

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